

REMARKS

Applicants' wish to thank Primary Examiner Dixon for the courtesies extended during the phone interview on February 4, 1999. During the interview Applicants asserted the non-analogous nature of the cited prior art, the lack of suggestion or motivation in the cited art to be combined in the manner proposed by the Examiner and that, even if combined, the cited prior art does not disclose each and every aspect of the invention as claimed. It was understood by Applicants that the arguments presented were persuasive and that the Examiner would contact Applicants' representative if favorable reconsideration were not forthcoming. As requested by the Examiner, a reiteration of Applicants' objections to the existing rejections is provided herewith.

Claims 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai('473) in view of Bryant('696). In view of Applicants' remarks below, Applicants respectfully submits that claims 9-17 are in condition for allowance. Accordingly, Applicants respectfully requests that the rejections to the claims be withdrawn and that the case now be passed to issue.

Formal Matters:

Page 1 of the Final Office Action indicates that claims 1-17 are finally rejected, while Page 2 of the Final Office Action states that claims 6-17 are finally rejected. Pursuant to the election by Applicants in the response filed on March 20, 1998 (paper number 3), claims 1-8 have been canceled, thereby leaving claims 9-16 and newly added claim 17 as those claims pending in the present application and presumably finally rejected by the Examiner in the Final Office Action of November 20, 1998.

In addition, the Final Office Action states that the claims are rejected over the cited prior art "for the reasons as set forth in the previous office action, **inter alia**." (emphasis added) It is not understood, therefore, if there are additional references or rationale over which claims 9-17 are rejected. If so, Applicants request that the Examiner make such references or rationale of record and notify Applicants of such references or rationale.

The 35 U.S.C. 103(a) Rejection of claims 9-17:

In response to Examiner's 35 U.S.C. 103(a) rejection of claims 9-17, Applicants submit that neither Arai ('473) nor Bryant ('696), taken alone or in combination, disclose each and every aspect of the claimed invention.

Applicants' invention, inter alia, comprises a method of manufacturing a drum assembly having a concave imaging surface and a shape which is greater than semi-cylindrical. The method as claimed in the present invention includes, generally, releasably wrapping one face of a drum skin partially around a mandrel, fixedly attaching a drum to a second face of the drum skin, generating a fluid bearing between the drum skin and the mandrel to separate the two and, finally, moving the drum and still attached drum skin away from the mandrel.

Turning now to the prior art cited by the Examiner, Applicants assert that there is no teaching, suggestion or motivation to combine Arai with Bryant, and further, that even if combined, the cited references do not disclose each and every element of at least the independent claim 9.

Arai is concerned with the method of manufacturing a lower cylinder of a guide drum assembly for use in a helical scan type magnetic recording/reproducing apparatus. The Examiner asserts that Arai teaches a method for making a drum assembly comprising "releasably wrapping a drum skin around a general cylindrical mandrel, attaching a drum to the skin and moving the drum and attached drum skin away from the mandrel (col. 1, line 65-col. 2, line 65)".

Firstly, the Examiner has sought to read Arai's magnetic tape 11 on Applicants' 'skin', as claimed in claim 9. Applicants do not understand Arai to disclose this element. The 'skin' recited in claim 9 is a constituent element of the claimed manufacturing method, while the magnetic tape of Arai is not utilized at all in the manufacture of Arai's lower cylinder. That is, Arai's method of manufacturing a lower cylinder, relied upon by the Examiner to show all but one aspect of the presently claimed invention, has no mention whatsoever of utilizing the magnetic tape 11. In fact, Arai does not disclose or suggest any manufacturing method which includes utilizing a 'skin' as is presently claimed in claim 9. Arai's magnetic tape is merely shown to illustrate how the lower cylinder, once manufactured, is utilized during the operation of a magnetic recording device.

Secondly, Arai does not disclose claim 9's recitation of 'moving the drum and attached drum skin ... in a direction parallel to the mandrel axis to remove the drum and attached drum skin from the mandrel while maintaining the fluid bearing between the drum skin and the mandrel'. As the Examiner has cited only the Summary portion of Arai, it is unclear what the Examiner is reading on Applicants' mandrel and drum, however, Applicants have examined the entirety of Arai's disclosure and have found no basis for claim 9's recitation in Arai. Likewise, claim 9 recites that the drum is 'fixedly' attached to the drum skin, while the device

manufactured in Arai would be inoperable if Arai's magnetic tape 'skin' were fixedly attached to whatever components the Examiner is reading upon either Applicants' mandrel or drum.

It is therefore Applicants' contention that Arai does not disclose or suggest any 'skin' which is utilized in any manufacturing method, that the 'skin' as represented by the Examiner is not fixed to any device at all and that the unidentified mandrel and drum of Arai do not move according to the recitation of claim 9.

The secondary reference, Bryant, is concerned with a tire building apparatus. The Examiner asserts that Bryant teaches "that it is well known in the art to provide separating means to drum assemblies and mandrel-type articles", and further, that it would have been obvious to combine this teaching to provide such separation means to Arai in the course of Arai's disclosed process.

Firstly, Applicants assert that one skilled in the manufacture of components in a magnetic recording apparatus would not look to the tire manufacturing art for modification, as such arts are dramatically different, i.e. non-analogous, from one another. Further, Applicants assert that one skilled in the art of manufacturing an imaging drum for an imaging device, as is presently claimed, would likewise not look to either the tire manufacturing art or the magnetic recording apparatus art, separately or in combination. As the claims must be read in light of the specification, Applicants contend that the technologies of the cited prior art differ so greatly from one another, as well as from the presently claimed invention, that the combination of Arai and Bryant could only have been made with impermissible hindsight on the part of the Examiner.

Secondly, Applicant's assert that there is simply no suggestion or motivation in either Arai or Bryant to combine the cited prior art in the manner proposed by the Examiner. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the present case, the Examiner contends that it would have been obvious to add Bryant's separation means to Arai's apparatus. Applicants disagree with such a contention. Arai does not teach or suggest that such a separation means would be desirable or could be incorporated into the manufacture of a recording apparatus. Similarly, Bryant does not teach or suggest that it would be desirable to incorporate its separation means in the manufacture of a recording apparatus or that its separation means could be incorporated in the manufacture of a drum assembly as is claimed in the present application.

Moreover, Applicants assert that Arai's disclosure teaches away from incorporating Bryant's separation means in that there is no need for a separation means in Arai. Arai's magnetic tape - the 'skin' which the Examiner suggests is to be removed by Bryant's separation means - freely passes over and around the cylinders and drums of Arai's magnetic recording apparatus, therefore no 'fluid bearing' is required to be generated in order to accomplish this separation of Arai's 'skin' from Arai's apparatus. Indeed, separating Arai's magnetic tape 'skin' from Arai's drum would result in an inoperable magnetic recording apparatus.

With respect to claim 17 in particular, the Examiner has stated that, "it is submitted that the cited references, as set forth, teaches the claimed limitations as discussed in the previous office action, inter alia, and for the reasons as discussed above." Firstly, Applicants assert that the Examiner has not set forth a prima facie case for the obviousness rejection of claim 17. As claim 17 recites elements not existing at the time of the previous Office Action, it is unclear how the discussion in the previous Office Action can hope to render these elements obvious. Also, the use of the phrase, 'inter alia', is again not understood. Applicants respectfully request that if there are additional references or rationale over which claim 17 is rejected, the Examiner make such references or rationale of record and notify Applicants of such references or rationale.

CONCLUSION

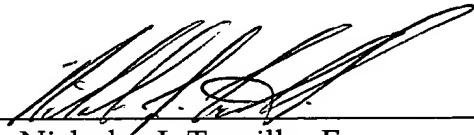
In light of the remarks above, Applicants respectfully request that the Examiner reconsider the existing rejections. Independent claim 9, and the claims dependent thereon, present patentable subject matter not disclosed by the cited prior art, either alone or in combination. Withdrawal of the rejections and passage of the case to issue is respectfully requested.

In the event that the Examiner does not pass the case to issue, Applicants respectfully request that another, non-final Office Action be issued in order to clarify the grounds over which claims 9-17 are rejected and to specifically point out the elements in both Arai and Bryant which are being read upon at least the elements of independent claim 9 and dependent claim 17, as discussed above.

As discussed during the interview on February 4, 1999, the Examiner is invited to contact the undersigned at the number below to expedite resolution of any issues that the Examiner may consider to remain unresolved.

Respectfully submitted,

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